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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,604	12/03/2003	David Brian Wecker	003797.00676	4652
28319 7590 09/05/2007 BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER VANCHY JR, MICHAEL J	
			ART UNIT 2624	PAPER NUMBER
			MAIL DATE 09/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/725,604

Applicant(s)

WECKER ET AL.

Examiner

Michael Vanchy Jr.

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date See Continuation Sheet.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :05/05/2006, 01/27/2006, 08/09/2005, 05/16/2005, 05/03/2005, 01/25/2005, 01/16/2004, 12/03/2003.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1,2, 6, 7, 15, 16, 19, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashizume et al., 5,513,278.**

**Re claim 1**, a method, comprising: receiving electronic ink input (Hashizume, Abstract); converting the electronic ink input to one or more machine-generated objects (Hashizume, Abstract); and rendering the one or more machine-generated objects such that a size of the machine-generated object or objects substantially corresponds to an original size of the electronic ink input (Hashizume, Abstract).

**Re claim 2**, a method according to claim 1, further comprising: determining the original size of the electronic ink input (Hashizume, Abstract and Fig. 7).

**Re claim 6**, a method according to claim 1, wherein the one or more rendered machine-generated objects are arranged so as to correspond to an original arrangement of the electronic ink input (Hashizume, col. 4, lines 4-8 and Fig. 12).

**Re claim 7**, a method according to claim 1, wherein the electronic ink input includes electronic ink text input, the one or more machine-generated objects includes machine-generated text, and the size of at least some of the machine-generated objects constitutes a font size of the machine-generated text (Hashizume, Abstract and Fig. 7).

**Re claim 15**, a system, comprising: an input adapted to receive electronic ink input; and a processor programmed (Hashizume, col. 3, lines 31-34) and adapted to: (a) convert the electronic ink input to one or more machine-generated objects, and (b) render the one or more machine-generated objects such that a size of the machine-generated object or objects substantially corresponds to an original size of the electronic ink input (Hashizume, Abstract).

**Re claim 16**, a system according to claim 15, wherein the electronic ink input includes electronic ink text input, the one or more machine-generated objects includes machine-generated text, and the size of at least some of the machine-generated objects constitutes a font size of the machine-generated text (Hashizume, Abstract and Fig. 7).

**Re claim 19**, a computer-readable medium including computer-executable instructions stored thereon for performing a method (Hashizume, col. 3, lines 31-34), comprising: receiving electronic ink input; converting the electronic ink input to one or more machine-generated objects; and rendering the one or more machine-generated objects such that a size of the machine-generated object or objects substantially

corresponds to an original size of the electronic ink input (Hashizume, Abstract and Fig. 7).

**Re claim 20**, a computer-readable medium (Hashizume, col. 3, lines 31-34) according to claim 19, wherein the electronic ink input includes electronic ink text input, the one or more machine-generated objects includes machine-generated text, and the size of at least some of the machine-generated objects constitutes a font size of the machine-generated text (Hashizume, Abstract and Fig. 7).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**5. Claims 3, and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashizume et al., 5,513,278.**

**Re claim 3**, a method according to claim 2, wherein the original size of the electronic ink input is determined based on an average size of at least a portion of the electronic ink input (Hashizume, Figures 8 and 11).

Although Hashizume et al. is silent on determining the original size of the electronic ink input based on an average size, it is apparent looking at Figures 8 and 11 that the size of the character is averaged based upon the area or areas the character crosses. Thus, the character is created into a machine-generated object, which is an "average size" of the original input.

**Re claim 8**, a method according to claim 7, further comprising: determining the original size of the electronic ink text input (Hashizume, Abstract and Fig. 7) on a word-by-word basis (Hashizume, col. 5, lines 27-33).

Although Hashizume et al. is silent on specifically stating "word-by-word basis" Hashizume does describe the ability to vary the setting of divided areas on a need basis. Also, Hashizume states that this can be used when using Japanese characters, which when taken by themselves are considered words. Thus, even though Hashizume doesn't specifically use the terminology "word-by-word basis" it is clear to one of ordinary skill in the art that the above mentioned is equivalent.

**Re claim 9**, a method according to claim 8, wherein the machine-generated text is rendered, on a word-by-word basis (Hashizume, col. 5, lines 27-33), at a font size based on the determined original size of the electronic ink text input (Hashizume, Abstract and Fig. 7).

Although Hashizume et al. is silent on specifically stating “word-by-word basis” Hashizume does describe the ability to vary the setting of divided areas on a need basis. Also, Hashizume states that this can be used when using Japanese characters, which when taken by themselves are considered words. Thus, even though Hashizume doesn’t specifically use the terminology “word-by-word basis” it is clear to one of ordinary skill in the art that the above mentioned is equivalent.

**Re claim 10**, a method according to claim 7, further comprising: determining the original size of the electronic ink text input as an average size (Hashizume, Abstract and Fig. 7) of a line of the electronic ink text input, on a line-by-line basis (Hashizume, col. 4, lines 4-8 and col. 5, lines 27-33).

Although Hashizume et al. is silent on specifically stating “line-by-line basis” Hashizume does describe the ability to vary the setting of divided areas on a need basis. The ability to display a “string” of recognized characters, also allows for the ability of selecting on a line-by-line basis. Thus, even though Hashizume doesn’t specifically use the terminology “line-by-line basis” it is clear to one of ordinary skill in the art that the above mentioned is equivalent.



**Re claim 11**, a method according to claim 10, wherein the machine-generated text is rendered, on a line-by-line basis (Hashizume, col. 4, lines 4-8 and col. 5, lines 27-33), at a font size based on the average size of the electronic ink text input line (Hashizume, Abstract and Fig. 7).

Although Hashizume et al. is silent on specifically stating "line-by-line basis" Hashizume does describe the ability to vary the setting of divided areas on a need basis. The ability to display a "string" of recognized characters, also allows for the ability of selecting on a line-by-line basis. Thus, even though Hashizume doesn't specifically use the terminology "line-by-line basis" it is clear to one of ordinary skill in the art that the above mentioned is equivalent.

**6. Claims 4, 5, 12-14, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashizume et al., 5,513,278, and further in view of Capps et al., 5,367,453.**

Hashizume et al. discloses the claimed invention but is silent about being able to display the electronic ink input and having machine generated text alternatives.

However, Capps et al. teaches these limitations:

**Re claim 4**, a method according to claim 1, further comprising: receiving input selecting at least one object from the rendered machine-generated object or objects; and displaying the electronic ink input corresponding to the selected machine-generated object or objects (Capps, Abstract and Figure 6a).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the apparatus of Hashizume et al., in view of Capps et al., such that it would provide the capabilities of displaying and selecting alternate words or objects, including the original electronic ink input.

**Re claim 5**, a method according to claim 4, wherein the displayed electronic ink input temporarily replaces the rendered machine-generated object or objects (Capps, Abstract and Figure 6a).

**Re claim 12**, a method according to claim 7, further comprising: receiving input selecting one or more words from the rendered machine-generated text; and displaying the electronic ink text input corresponding to the selected machine-generated text (Capps, Abstract and Figure 6a).

**Re claim 13**, a method according to claim 12, further comprising: displaying machine-generated text alternatives corresponding to the selected one or more words (Capps, Abstract and Figure 6a).

**Re claim 14**, a method according to claim 13, further comprising: receiving input selecting a displayed machine-generated text alternative; and replacing the selected rendered machine-generated text with the selected displayed machine-generated text alternative (Capps, Abstract and Figure 6a).

**Re claim 17**, a system according to claim 16, wherein the input is further adapted to receive a selection of one or more words from the rendered machine-generated text, and wherein the processor is further programmed and adapted to display the electronic ink text input corresponding to the selected machine-generated text and to display machine-generated text alternatives corresponding to the selected one or more words (Capps, Abstract and Figure 6a).

**Re claim 18**, a system according to claim 17, wherein the input is further adapted to receive a selection of a displayed machine-generated text alternative, and the processor is further programmed and adapted to replace the selected rendered machine-generated text with the selected displayed machine-generated text alternative (Capps, Abstract and Figure 6a).

***Examiner's Note***

The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock,

Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

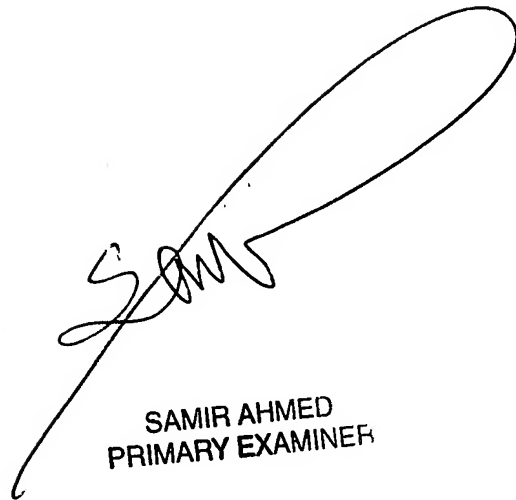
However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Vanchy Jr. whose telephone number is (571) 270-1193. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached on (571) 272-7413. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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